

REMARKS

Claims 1, 3-16, 18-31 and 33-45 are pending in the present application. By this Response, claims 1, 16 and 31 are amended and claims 2, 17 and 32 are canceled. Claims 1, 16 and 31 are amended to incorporate subject matter similar to the subject matter of canceled claims 2, 17 and 32. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

I. 35 U.S.C. § 102, Alleged Anticipation, Claims 1, 6-15, 16, 21-30, 31 and 36-45

The Office Action rejects claims 1, 6-15, 16, 21-30, 31 and 36-45 under 35 U.S.C. § 102(b) as being allegedly anticipated by Bremer (U.S. Patent No. 6,018,671). This rejection is respectfully traversed.

As to claims 1, 16 and 31, the Office Action states:

Regarding claims 1, 16 and 31 Bremer discloses a method for answering a wireless telephone, the method comprising:
receiving an incoming call (see fig. 1 (102), col. 1, lines 55-58);
responsive to a determination that automatic call answering has been selected by a user (see col. 4 lines 16 - 21), answering the incoming call by providing the calling party with an indication that the user will take the call momentarily and placing the wireless telephone in mute mode until the user has taken the incoming call (see col. 4 lines 43 - 51).

Office Action dated November 24, 2003, page 2.

Claim 1, which is representative of the other rejected independent claims 16 and 31 with regard to similarly recited subject matter, reads as follows:

1. A method for answering a wireless telephone, the method comprising:
receiving an incoming call;
responsive to a determination that automatic call answering has been selected by a user, answering the incoming call by providing the calling party with an indication that the user will take the call momentarily and placing the wireless telephone in mute mode until the user has taken the incoming call, wherein the indication that the user will take the call momentarily provides an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. In *re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. In *re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Bremer does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, Bremer does not teach where the indication that the user will take the call momentarily provides an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation.

Bremer is directed to a device that includes a silent alert allowing the device to signal the user of an incoming call without an audible alert. The device further includes a key actuated by the user to accept the call into a non-active state. A prerecorded message is generated from a memory and played for the calling party to inform the caller that the user is occupied, but will answer the call shortly. Furthermore, the user can interrupt the message and enter the active call state at any time during the silent answer and hold subroutine.

Bremer does not teach providing an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation when indicating to the calling party that the user will take the call momentarily, as recited in claim 1. Bremer teaches a device that is based upon users conducting conversations using normal speech and, in the event the called party is using the phone, providing the calling party with a prerecorded message to inform the caller that the user is occupied, but will answer the call shortly. Bremer is not concerned with whether the called party will conduct their end of the conversation using a speech phrase generator. The Applicants agree with the Office Action that Bremer does not teach the above feature (see Office Action, page 4).

However, Applicants respectfully disagree with the Office Action's allegation that this feature is taught by Leviton.¹

Leviton is directed to a voice communications system that is conducted by transmitting symbols representative of a user's voice from a transmitting communications device and recreating the user's voice at a receiving communications device. The communications devices each include a processing engine responsive to a user's voice input for generating speech sample data indicative of predetermined portions of the user's voice. While Leviton may teach the use of a speech phrase generator, nowhere in the Leviton reference is it taught or suggested to send an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation. In fact, there is no need for an indication to the calling party that the user will be using a speech generation device to conduct a conversation, as the determination as to whether the conversation will make use of a speech generation device is performed after the communications link has been established. The Office Action alleges that this feature is taught by Leviton at column 5, lines 5-7, which reads as follows:

At step 402, communications device 101.2 responds to a phone ring or network connection request initiated by device 101.1. At step 404, device 101.2 establishes communications with the originating device 101.1 and exchanges configuration and preference information at step 406. The recipient at device 101.2 is given an option of conducting the conversation by way of generic speech generation or in accordance with the principles of the present invention from speech samples 112.

In this section Leviton describes that, after the receiving device establishes communications with the originating device, configuration and preference information are exchanged. Then, the recipient is given an option of conducting a conversation by way of generic speech generation or using a speech generation device. Thus, there is no need to provide an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation when indicating to the calling party that the user will take the call momentarily, as Leviton implements this process after the call is established.

¹ Applicants are addressing obviousness in this section as claim 1 was amended to incorporate subject matter similar to canceled claim 2, which the Office Action rejects under 35 U.S.C. § 103(a).

Thus, neither Bremer nor Leviton teach or suggest where the indication that the user will take the call momentarily provides an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation. Moreover, there is no suggestion in either of the references to include such features. That is, there is no teaching or suggestion in Bremer or Leviton that a problem exists for which providing an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation is a solution. To the contrary, Bremer merely teaches indicating that the user will take the call momentarily. Leviton teaches that, after the receiving device establishes communications with the originating device, configuration and preference information are exchanged. Then, the recipient is given an option of conducting a conversation by way of generic speech generation or using a speech generation device.

One of ordinary skill in the art, being presented only with Bremer and Leviton and without having prior knowledge of Applicants' claimed invention, would not have found it obvious to combine and modify Bremer and Leviton to arrive at Applicants' claimed invention. To the contrary, even if one were somehow motivated to combine Bremer and Leviton, and it were somehow possible to combine the two systems, the result would not be the invention, as recited in claim 1. The result would be a device that indicates that the user will take the call momentarily and, after the call is established, exchange configuration and preference information and decide to conduct the conversation by way of generic speech generation or using a speech generation device.

Thus, Bremer does not teach each and every feature of independent claims 1, 16 and 31 as required under 35 U.S.C. § 102(b). At least by virtue of their dependency on independent claims 1, 16 and 31, respectively, Bremer does not teach each and every feature of dependent claims 6-15, 21-30 and 36-45. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 6-15, 16, 21-30, 31 and 36-45 under 35 U.S.C. § 102(e).

Furthermore, Bremer does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. In fact, Bremer does not even provide an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation. Absent the Examiner pointing out some teaching or

incentive to implement Bremer to provide an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation, one of ordinary skill in the art would not be led to modify Bremer to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Bremer in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

Moreover, in addition to their dependency from independent claims 1, 16 and 31, respectively, Bremer does not teach the specific features recited in dependent claims 6-15, 21-30 and 36-45. For example, with regard to claims 10, 25 and 40, Bremer does not teach where the voice message is generated by a voice generation unit. The Office Action alleges that Bremer teaches this feature at column 2, lines 29-36, which reads as follows:

A memory 126 storing messages and an answering circuit 128 are also connected to the controller 110. The answering circuit is any suitable commercially available circuit implementing answering machine functions such as playing a recorded message and recording a caller's response to the recorded message.

In this section Bremer is describing an answering machine that will record messages from a calling party. There is nothing in this section, or any other section of Bremer, that teaches providing the calling party with an indication that the user will take the call momentarily includes sending a voice message, which is generated by a voice generation unit, to the calling party. Though Bremer may teach responding to the calling party with a default message telling the caller that they are on hold and the call will be answered shortly, a recorded message that the called party can not answer soon, but the caller can leave a message, a message that the called party is unavailable, a message giving the caller the option to forward the call to another number or to forward the call to a network voice mail service, or any other message that the user wants to save in the memory, nowhere in any section of Bremer is it taught that the user may respond using a voice generation unit.

Therefore, in addition to being dependent on independent claims 1, 16 and 31 respectively, dependent claims 6-15, 21-30 and 36-45 are also distinguishable over

Bremer by virtue of the specific feature recited in these claims. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 6-15, 21-30 and 36-45 under 35 U.S.C. § 102(b).

II. 35 U.S.C. § 103, Alleged Obviousness, Claims 2-5, 17-20 and 32-35

The Office Action rejects claims 2-5, 17-20 and 32-35 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bremer (U.S. Patent No. 6,018,671) in view of Leviton et al. (U.S. Patent No. 6,501,751 B1). This rejection is moot with regard to canceled claims 2, 17 and 32 and is respectfully traversed with regard to the remaining claims.

The subject matter of claims 2, 17 and 32 has been incorporated into claims 1, 16 and 31, respectively. This subject matter distinguishes over Bremer for at least the reasons noted above with regard to claims 1, 16 and 31. That is, Bremer does not teach or suggest providing an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation when indicating to the calling party that the user will take the call momentarily. Moreover, Leviton does not provide for the deficiencies of Bremer and thus, any combination of Leviton with Bremer would not be sufficient to reject independent claims 1, 16 and 31 from which dependent claims 3-5, 18-20 and 33-35 depend, respectively.

Leviton is directed to a voice communications system that is conducted by transmitting symbols representative of a user's voice from a transmitting communications device and recreating the user's voice at a receiving communications device. The communications devices each include a processing engine responsive to a user's voice input for generating speech sample data indicative of predetermined portions of the user's voice. While Leviton may teach the use of a speech phrase generator, nowhere in the Leviton reference is it taught or suggested to send an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation. In fact, there is no need for an indication to the calling party that the user will be using a speech generation device to conduct a conversation, as the determination as to whether the

conversation will make use of a speech generation device is performed after the communications link has been established.

Thus, neither Bremer nor Leviton teach or suggest providing an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation when indicating to the calling party that the user will take the call momentarily. Since neither reference teaches or suggests this feature, any alleged combination of the references still would not result in this feature being taught or suggested. Moreover, there is no teaching or suggestion in either reference to modify the teachings of the references to include this feature. To the contrary, Leviton actually teaches away from such a modification and Bremer does not provide any teaching regarding providing an indication to the calling party that the user will be using a speech phrase generator to conduct a conversation when indicating to the calling party that the user will take the call momentarily, as recited in independent claims 1, 16 and 31.

Claims 3-5, 18-20 and 33-35 depend from independent claims 1, 16 and 31, respectively, and thus, these claims distinguish over the alleged combination of Bremer and Leviton for at least the reasons noted above with regard to claims 1, 16 and 31. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-5, 18-20 and 33-35 under 35 U.S.C. § 103(a).

Moreover, neither Bremer nor Leviton, either alone or in combination, teach or suggest the specific features recited in dependent claims 3-5, 18-20 and 33-35. For example, with regard to claims 3, 18 and 33, neither Bremer nor Leviton, either alone or in combination, teach or suggest responsive to selection of a speech phrase by the user, sending a speech phrase to the calling party. The Office Action alleges that Leviton teaches this feature at column 5, lines 5-7, shown above. As discussed above, this section Leviton describes that, after the receiving device establishes communications with the originating device, configuration and preference information are exchanged. Then, the recipient is given an option of conducting a conversation by way of generic speech generation or using a speech generation device. There is nothing in this section, or any other section of Leviton, that teaches or suggests sending a speech phrase to the calling party in response to selection of a speech phrase by the user. In fact, Leviton teaches a system that converts the received speech from the user of the corresponding

communications device into phonetically equivalent text in accordance with the appropriate speech sample. Thus, there is no provision, nor no need, in Leviton to allow a user to select a speech phrase and send the speech phrase to the calling party, as Leviton provides for automatic conversion of the received speech.

Thus, in addition to being dependent on independent claims 1, 16 and 31, respectively, dependent claims 3-5, 18-20 and 33-35 distinguish over the alleged combination of Bremer and Leviton based on the specific features recited therein.

III. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: February 24, 2004

Francis Latnmes

Francis Latnmes
Reg. No. P-55,353
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001
Agent for Applicants

SRT/fl